

10/748,9911589/SYMBP187USREMARKS

Claims 1-29 are currently pending in the subject application and are presently under consideration. A clean version of all pending claims is found at pages 2-5. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-3, 7-12, 15-16, 19, 21-26 and 29 Under 35 U.S.C. §103(a)

Claims 1-3, 7-12, 15-16, 19, 21-26 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kfouri *et al.* (US 2003/0044000) in view of Kumar (US 5,386,106). Reversal of this rejection is requested for at least the following reasons. Kfouri *et al.* and Kumar, individually or in combination, do not teach or suggest each and every element set forth in the subject claims.

To reject claims in an application under §103, an examiner must show an unrebutted *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Federal Circuit has also held that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. See *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed Cir. 1999).

Applicant's claimed invention relates to systems and methods for facilitating orientation of a display upon a machine data reader, such as a barcode scanner, based at least in part upon a user-defined orientation of a moveable keypad. Independent claims 1, 15 and 23 recite similar elements, namely: *a keypad that is moveable with respect to a body of the machine data reader, the keypad utilized to relay information to the machine data reader; a component that senses a position of the keypad; and a component that orients the display based at least in part upon the sensed position of the keypad.* In particular, the claimed invention enables a keypad and display

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to be oriented desirably to a user when attempting to enter data into the machine data reader. The machine data reader is typically a wearable barcode scanner that can be attached to either arm of a user. Kfouri *et al.* and Kumar, individually or in combination, fail to teach or suggest such aspects of the claimed invention.

Kfouri *et al.* relates to an electronic device having a rotatable keypad and display. The housing of the electronic device has a physically rotatable keypad and an electronically rotatable display image. A sensor provides a sensor signal representative of the orientation of the keypad relative to the housing of the electronic device. The keypad has a plurality of keys in a key housing and a plurality of key sensors that sense activation of the keys. The keypad has at least first and second and possibly third orientations (See Page 1, Paragraphs 0015-0017). At Page 3 of the Office Action (dated 8-9-05), the Examiner admits that Kfouri *et al.* fails to teach that the electronic device is a machine data reader, such as a wearable barcode scanner, as disclosed in the subject claims.

Kumar does not make up for the aforementioned deficiencies of Kfouri *et al.* with respect to independent claims 1, 15 and 23 (which claims 2-3, 7-12, 16, 19, 21-22, 24-26 and 29 depend therefrom). Kumar *et al.* relates to a handheld, portable device for processing point of sale transactions. The portable device includes a housing for carrying the components; a reader for reading the credit card information; a scanner for scanning product identification information; and a printer for printing a customer receipt (See Col. 2, lines 38-64).

Kfouri *et al.* and Kumar cannot be combined to make the present invention obvious because there is not proper suggestion or motivation to combine the references' teachings to create the subject matter of independent claims 1, 15 and 23. In general, the rationale proffered to combine such teachings is to achieve benefits identified in applicant's specification, to overcome problems associated with conventional methods, etc. Applicant respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103(a). In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in Applicant's specification. This sort of rationale has been condemned by the CAFC; see, for example, *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). Thus, the contention that the modification of a hand held, portable electronic device to a barcode scanner with a rotatable keypad to alleviate readability problems for the user, would have been

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obvious in view of the teachings of Kfouri *et al.* and Kumar constitutes nothing more than hindsight speculation.

In view of the aforementioned deficiencies of Kfouri *et al.* and Kumar, and because the requisite teaching or suggestion to combine the elements in the manner suggested is absent from the cited references, it is respectfully submitted that this rejection be withdrawn with respect to independent claims 1, 15 and 23 (which claims 2-3, 7-12, 16, 19, 21-22, 24-26 and 29 depend therefrom).

II. Rejection of Claims 4-5 and 20 Under 35 U.S.C. §103(a)

Claims 4-5 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kfouri *et al.*, in view of Kumar and further in view of Charlier *et al.* (US 2003/0064751). It is respectfully submitted that this rejection should be withdrawn for the following reasons. Kfouri *et al.*, Kumar and Charlier *et al.*, individually or in combination, do not teach or suggest each and every element set forth in the subject claims. In particular, Charlier *et al.* does not make up for the aforementioned deficiencies of Kfouri *et al.* and Kumar with respect to independent claims 1 and 15 (which claims 4-5 and 20 depend therefrom). Thus, the subject invention as recited in claims 4-5 and 20 is not obvious over the combination of Kfouri *et al.*, Kumar and Charlier *et al.*. Therefore, it is respectfully submitted that this rejection be withdrawn.

III. Rejection of Claims 6, 13-14, 17-18 and 27-28 Under 35 U.S.C. §103(a)

Claims 6, 13-14, 17-18 and 27-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kfouri *et al.*, in view of Kumar and further in view of Knox (US 6,004,049). It is respectfully submitted that this rejection should be withdrawn for the following reasons. Kfouri *et al.*, Kumar and Knox, individually or in combination, do not teach or suggest each and every element set forth in the subject claims. In particular, Knox does not make up for the aforementioned deficiencies of Kfouri *et al.* and Kumar with respect to independent claims 1, 15 and 23 (which claims 6, 13-14, 17-18 and 27-28 depend therefrom). Thus, the subject invention as recited in claims 6, 13-14, 17-18 and 27-28 is not obvious over the combination of Kfouri *et al.*, Kumar and Knox. Therefore, it is respectfully submitted that this rejection be withdrawn.

10/748,9911589/SYMBP187US**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP187US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731